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PATENT APPLICATION
SERIAL NO. 09/065,787

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

Adams, et al.

Serial Number: 09/065,787

Group Art Unit: 2662

Filed: April 23, 1998

Examiner: Logsdon, J.

For: METHODS AND SYSTEMS FOR A
TELEPHONE E-MAIL INTERFACE

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APPELLANTS' REPLY BRIEF

1. INTRODUCTION

Appellants and assignee Nortel Networks Limited (formerly Northern Telecom Limited) respectfully submit the present reply brief in further support of the patentability of the claims of the above-referenced application.

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A. Summary of the Invention and Its Advantages

The present invention comprises a method and apparatus for providing an automated interface to transfer a voice message from a calling party in a voice network to a recipient in a data network (for example, the Internet) by means of the calling party entering the recipient's e-mail address into the telephone instrument. (Application, p. 4, lns. 2-4). The invention solves the problem of getting a voice message to someone who has an e-mail account on a data network (but who may not have a telephone or voice-mail system) where the caller has the recipient's e-mail address but only has access to a telephone on the voice network. The present invention does not require pre-planning on the part of either the caller or the recipient, thus enabling "pay-per-use" services. (Application, p. 3, lns. 7-13; p. 4, lns. 2-4). The present invention permits a called party to receive a voice message even if the called party does not have a telephone or even a telephone number. It is respectfully submitted that this solution, and the advantages flowing from it, is neither shown in the prior art nor would have been obvious therefrom.

II. ARGUMENT

A. Legal Requirements for Obviousness

The procedure that must be followed in applying Section 103 in making an obviousness determination is set forth in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966):

Under Section 103, the scope and content of the prior art are to be determined; the differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as

commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

See, also, Manual of Patent Examining Procedure (M.P.E.P.) Section 2141.

During prosecution, the Examiner has the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. §2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and may not be based on applicant's disclosure. *Id. See, also, In re Vaecki*, 947 F.2d 488, 20 USPQ 1438 (Fed.Cir. 1991); M.P.E.P. §2143.

If a *prima facie* case of obviousness is established, the burden shifts to the applicant to come forward with arguments and/or evidence to rebut the *prima facie* case. *See, In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1896, 1901 (Fed.Cir. 1990), *cert. denied*, 500 U.S. 904 (1991). Even if the examiner determines there is factual support for rejecting the claimed invention under 35 U.S.C. §103, the Examiner must consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the applicant. The ultimate determination of patentability must be based on the entire record, by a preponderance of

evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed.Cir. 1992).

B. Illustrative Claim 1 of the Application

For the Board's convenience, claim 1 is reproduced below, with a key limitation italicized:

1. The method of automating the delivery of a voice originated message to a data network recipient comprising the steps of:

inputting a recipient e-mail address received from a calling party to be stored in a service provider;

supplying a voice originated message to be stored in the service provider; and

converting the stored voice originated message to a data network format.

(Emphasis added). The foregoing emphasized limitation is also found in substance in the remaining claims under rejection, though variously phrased.

C. The Arguments in the Examiner's Answer Do Not Support a Finding of Obviousness

a. The Examiner's Argument for a *Prima Facie* Showing of Obviousness Is Legally and Factually Flawed

In his Answer, the Examiner argues that "all that is necessary" is that the Examiner's asserted fact that "e-mail addresses are oftentimes easy for users to remember" would have been obvious, even though that asserted fact is not found in the prior art of record. (Examiner's Answer dated July 2, 2003, pg 9). The Examiner, however, cites no authority for his proposition. Appellants respectfully traverse the argument made by the Examiner.

Under applicable law, it is fundamental that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and may not be based on the applicant's disclosure. *Id. See, also, In re Vaecki*, 947 F.2d 488, 20 USPQ 1438 (Fed.Cir. 1991). Of course, the rationale for combining references may be based on scientific principles, legal precedents, or knowledge available to one of ordinary skill in the art. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); M.P.E.P. §2144. However, the motivation to combine references must be found in one of these sources and may not be based on Appellants' disclosure.

Here, the prior art does not teach the desirability of having a calling party (i.e., a person using a telephone instrument) send an e-mail message including an attached voice originated message by inputting the recipient's e-mail address or that e-mail addresses are necessarily "easy to remember." Rather, Appellant's disclosure discloses that "[i]t would be convenient to contact a person by e-mail through the use of a standard telephone ... [which] are typically more accessible ... than are network computers." (Application, p. 3). Hence, in contrast to the Examiner's argument, the motivation to send an e-mail message including an attached voice originated message by inputting the recipient's e-mail address is, in fact, found in Appellant's disclosure. Absent Appellant's own teaching, it is respectfully submitted that it would not have been *prima facie* obvious at the time of the invention to one of ordinary skill in the art to combine the teachings of Brown (US 6,014,711) and Hyde-Thomson (US 5,717,742).

b. The Examiner Improperly Failed to Accord Any Weight to Appellants' Showing of Disadvantages with the Examiner's Proposed Combination

In the Examiner's Answer, the Examiner has failed to accord any weight to Appellants' showing of disadvantages to the combination of Brown and Hyde-Thomson and has dismissed those considerations as "irrelevant." (Examiner's Answer dated July 2, 2003, p. 9). With due respect to the Examiner, it is respectfully submitted that dismissing Appellant's showing of disadvantages as "irrelevant" was legal error inconsistent with controlling Supreme Court precedent.

The Supreme Court has held that "[k]nown disadvantages in old devices which would naturally discourage search for new inventions may be taken into account in determining obviousness." *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966). Here, in order to combine the teachings of Brown and Hyde-Thomson, one of ordinary skill in the art would have to ignore the fact that the entry of alpha-numeric e-mail addresses via a telephonic keypad is difficult and disadvantageous, as opposed to using the alpha-numeric keypad of a general-purpose computer, as taught in the prior art (Hyde-Thomson, col. 3, lns. 54-67). *United States v. Adams* provides for consideration of such disadvantages prior to a determination of obviousness. *United States v. Adams*, *supra*, 383 U.S. at 52, 148 USPQ at 484. Accordingly, it is respectfully submitted that the Examiner's failure to accord any weight to Appellant's showing of disadvantages was legal error, leading to an erroneous conclusion of obviousness.

c. Appellants Use of a Telephone Instrument to Enter the E-mail Address Is Contrary to Conventional Wisdom

Where an inventor's "insight was contrary to the understandings and expectations of the art, the structure effectuating it would not have been obvious to those skilled in the art." *Schenck v. Nortron Corp.*, 713 F.2d 782, 785, 218 USPQ 698, 700 (Fed.Cir. 1983). [NEED PINPOINT] Here, conventional wisdom in the art was that, to create a voice-mail to be attached to an e-mail using a telephone device, one either needed a computer to input the e-mail address directly (as in Hyde-Thomson) or one needed to have a translator and to create a look-up table to convert "unique identifiers" (for example, telephone numbers) into e-mail addresses (as in Brown).

Here, conventional wisdom was to the effect that it was not practical to attempt to enter e-mail addresses into a telephone keypad directly. Otherwise, there would have been no purpose for the translator in Brown and no purpose for requiring a computer to enter the e-mail address, as in Hyde-Thomson. In providing for direct inputting of the e-mail address by the telephone caller, the present invention proceeded contrary to this conventional wisdom. This also supports a finding of non-obviousness. *See, e.g., Schenck v. Nortron Corp., supra.*

The Examiner asserts that, although the "appellants [argue] that inputting an e-mail address without using a computer is contrary to conventional wisdom . . . the claims nowhere teach that no computer is used." (Examiner's Answer dated July 2, 2003, pg 10). Appellants respectfully traverse the Examiner's argument as factually incorrect.

In contrast to the Examiner's argument, it is clear from the specification of the present invention that the use of the term "calling party" in the claims requires the use of

a telephone instrument. For example, the specification states “[i]n FIGURE 1, a calling party [uses] a telephone type instrument to communicate through telephone lines and a telephone network.” (Application, p. 6). Nowhere in the application is a general-purpose computer used for this purpose. Hence, as properly construed in light of the specification, use of the term “calling party” in the claims requires use of a telephone instrument rather than merely a general-purpose computer.

d. Appellants’ Omission of the Need for Steps Required by Brown and Hyde-Thomson Shows Non-Obviousness

Brown requires the user to create, in advance, a look-up table correlating telephone numbers and e-mail addresses. Creating this table requires pre-planning on the part of the recipient, and is cumbersome. Brown further requires that, during operation, the system take the steps of looking up the entered telephone number and translating it to the correlated e-mail address. In Brown, these steps are apparently considered necessary to avoid the disadvantages attendant to the limitations of a telephone keypad. Combining Hyde-Thomson (which provides for direct entry of the e-mail address into a computer) does not solve this problem, because the caller may not have access to a computer at the time he/she desires to leave a voice message.

“While it may often be true that the mere omission of an element together with its function does not produce a patentable invention, it may also be unobvious to omit an element while *retaining* its function.” *In re Edge*, 359 F.2d 896, 899, 149 USPQ 556, 557 (CCPA 1966). (Emphasis added.) In the present invention, Appellants disclose multiple examples of the use of the present invention that do not require essential features of Brown and Hyde-Thomson. For example “bob@bnr.ca might be entered as: 2-2 6-6-6

2-2 * 2-2 6-6 7-7 ** 2-2-2 2 #" by means of a telephone keypad (Application, pg 8).

Also, “[t]he addressing of a recipient may also be accomplished through a variation of ‘speed dialing.’” *Id.* In neither case does the present invention require a look-up table step (as in Brown) or use of a computer and its alpha-numeric keyboard to enter e-mail addresses (as in Hyde-Thomson).

The Examiner asserts that, although “appellants [argue] that omissions of steps in the claims renders the claims non-obvious . . . the claims nowhere state that steps are indeed omitted.” (Examiner’s Answer dated July 2, 2003, pg 10). Appellants respectfully traverse the Examiner’s argument as factually incorrect.

The claims on appeal do not include any requirement for creation or use of a look-up table step (as required by Brown) or use of a computer and its alpha-numeric keyboard to enter e-mail addresses (as required by Hyde-Thomson). The omission of the requirement for these steps in the claims is, in fact, omission of these steps. Accordingly, the omission of the requirement for these steps in the claims further supports a finding of non-obviousness.

e. The Present Invention Solves Problems Not Solved by Brown or Hyde-Thomson, Even If Combined.

A person frequently has multiple telephone numbers and multiple e-mail addresses that are used at different times or under different circumstances, and there often is no unique association between a particular telephone number and a particular desired e-mail address. The hypothetical combination proposed by the Examiner provides no solution to the problem of what to do when there is no unique association between the telephone number and the desired e-mail address, or where the telephone number/e-mail

address pair has not yet been entered into the table, and the caller does not have access to a computer. The present invention does solve this problem.

The present invention, by permitting the caller to input the desired e-mail address directly into a telephone instrument, permits leaving a recipient a voice-mail message without the calling party having a computer, without knowing the recipient's telephone number and without the need for the recipient to even have a telephone. Furthermore, neither the recipient nor the caller need to do anything in advance (such as creating a look-up table associating his/her telephone number(s) with his/her e-mail address(es)). Thus, unlike Brown (which requires the recipient to previously set up the look-up table), and unlike Hyde-Thomson (which requires the caller to have access to a computer or to know the recipient's voice mailbox number), no pre-planning or other preparations are required on the part of either the caller or the recipient. The present invention thus enables services, such as pay-per-use telephone services, where neither the caller nor the intended recipient need to do anything in advance, such as buying special equipment, inputting a list of telephone numbers correlated to e-mails in advance, etc. This would not be possible under even the hypothetical combination of Brown and Hyde-Thomson relied upon by the Examiner in the rejection under 35 U.S.C. §103(a).

"[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is *part* of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. 103." *In re Sponnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969). Here, the inventors' recognition that the most important problems were that the recipient would seldom set up the required look-up

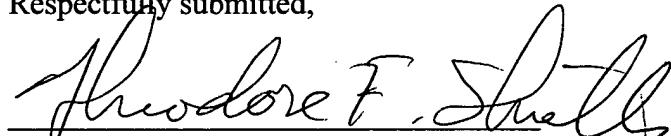
table in advance and that the caller could often not have access to a computer, and that this advantage overcame the disadvantages and limitations of using a telephone instrument to input an e-mail address, led to the solution of permitting the caller to input an e-mail address into a telephone. Accordingly, the Appellants' recognition of these problems – and their solution – further supports a finding of non-obviousness. *See, In re Sponnoble, supra.*

III. CONCLUSION

For the foregoing reasons, it is respectfully submitted that the Final Rejection of claims 1-42 under 35 U.S. C. §103(a) is improper and should be reversed.

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Respectfully submitted,


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